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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/877,687	06/08/2001	Matthew J. Holliman	42390.P11076	9438

45209 7590 01/05/2010

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EXAMINER

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ART UNIT	PAPER NUMBER
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2448

MAIL DATE	DELIVERY MODE
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01/05/2010

PAPER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MATTHEW J. HOLLIMAN, RAINER W. LIENHART,
MINERVA M. YEUNG, YEN-KUANG CHEN, IGOR V. KOZINTSEV,
and LI-CHENG TAI

Appeal 2009-003583
Application 09/877,687
Technology Center 2400

Decided: January 5, 2010

Before JAMES D. THOMAS, HOWARD B. BLANKENSHIP, and
ST. JOHN COURTENAY III, *Administrative Patent Judges*.

COURTENAY, Administrative Patent Judge.

DECISION ON APPEAL

STATEMENT OF THE CASE

This is a decision on appeal under 35 U.S.C. § 134(a) from the Examiner's final rejection of claims 80-109. Claims 1-79 have been cancelled. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

The Invention

Appellants' invention relates generally to providing a multimedia, peer-to-peer computing platform. More particularly, Appellants' invention relates to a multimedia-aware delivery system. (Spec. Para. [0004]).

Claim 80 is illustrative:

80. A method comprising:

- a first peer node receiving an inquiry for data from a second peer node, the inquiry including a user specified search string and specifying a format for the data:

- generating a cost value based in part on conversion of the data to the specified format;

- adding the cost value to a packet that also includes a cost value generated by another peer node and then providing the packet to the second peer node;

- the first peer node converting the data into the specified format before transmitting the data to the second peer node;

- transmitting the data to the second peer node in a transport specification specified by the second peer node.

Prior Art

The Examiner relies upon the following references as evidence:

Meempat	US 6,778,496 B1	Aug. 17, 2004
Schneider	US 6,687,753 B2	Feb. 3, 2004
Carolan	US 6,965,569 B1	Nov. 15, 2005
Dutta	US 2002/0073204 A1	Jun. 13, 2002
Agrawal	US 6,072,784	Jun. 6, 2000
Zhang	US 6,891,854 B2	May 10, 2005
Sato	US 7,088,775 B2	Aug. 8, 2006
VanHeyningen	US 2003/0023845 A1	Jan. 30, 2003
Goossen	US 2005/0108436 A1	May 19, 2005
Horn	US 2001/0022000 A1	Sep. 13, 2001
Neogi	US 6,650,620 B1	Nov. 18, 2003

The Rejections^{1 2}

1. The Examiner rejected claims 80-82, 84, 86, 88, 91-94, 96, 100-102, and 105-107 under 35 U.S.C. § 103(a) as unpatentable over the combination of Dutta, Schneider, Meempat, and Carolan.
2. The Examiner rejected claims 83 and 95 under 35 U.S.C. § 103(a) as unpatentable over the combination of Dutta, Schneider, Meempat, Carolan, and Agrawal.
3. The Examiner rejected claim 85 under 35 U.S.C. § 103(a) as unpatentable over the combination of Dutta, Schneider, Meempat, Carolan, and Zhang.
4. The Examiner rejected claims 87, 97, and 108 under 35 U.S.C. § 103(a) as unpatentable over the combination of Dutta, Schneider, Meempat, Carolan, and Sato.

¹ The rejections of claims 83, 85, 87, 89, 90, 95, 97-99, 103, 104, 108, and 109 are not separately argued by Appellants. Arguments that Appellants could have made but chose not to make in the Briefs are waived. *See* 37 C.F.R. § 41.37(c)(1)(vii) (“Notwithstanding any other provision of this paragraph, the failure of appellant to separately argue claims which appellant has grouped together shall constitute a waiver of any argument that the Board must consider the patentability of any grouped claim separately.”).

5. The Examiner rejected claims 89, 98, and 109 under 35 U.S.C. § 103(a) as unpatentable over the combination of Dutta, Schneider, Meempat, Carolan, and VanHeyningen.
6. The Examiner rejected claims 90 and 99 under 35 U.S.C. § 103(a) as unpatentable over the combination of Dutta, Schneider, Meempat, Carolan, and Goossen.
7. The Examiner rejected claim 103 under 35 U.S.C. § 103(a) as unpatentable over the combination of Dutta, Schneider, Meempat, Carolan, and Horn.
8. The Examiner rejected claim 104 under 35 U.S.C. § 103(a) as unpatentable over the combination of Dutta, Schneider, Meempat, Carolan, and Neogi.

Appellants' Contentions

Combinability of the references

1. Appellants contend that Dutta, Schneider, Meempat, and Carolan do not contain any suggestion that they be combined. (App. Br. 12).

² The rejection of claims 80-109 under 35 U.S.C. §112, second paragraph, has been withdrawn by the Examiner. (See Ans. 16)

2. Appellants contend that at least two of Dutta, Schneider, Meempat, and Carolan are from non-analogous arts. (App. Br. 12).
3. Appellants contend that it seems likely that it would be necessary to make modifications that are not taught or suggested in the prior art in order to combine Dutta, Schneider, Meempat, and Carolan given the vast differences in the technical fields of the references. (App. Br. 14).
4. Appellants contend that the fact that the Examiner needed to combine such a large number of references in order to meet the claimed invention is evidence that the invention is not obvious. (App. Br. 17).

Limitations under § 103

5. Appellants contend that the cited references fail to teach or suggest specifying a format for the data, as claimed. (App. Br. 16).
6. Appellants contend that the cited references fail to teach or suggest generating a cost value, as claimed. (App. Br. 16).

ISSUES

Based upon our review of the administrative record, we have determined that the following issues are dispositive in this appeal:

1. Have Appellants shown the Examiner erred in combining the cited references under § 103?

2. Have Appellants shown the Examiner erred in finding that the cited references teach or would have suggested the recited limitation of specifying a format for the data?
3. Have Appellants shown the Examiner erred in finding that the cited references teach or would have suggested the limitation of generating a cost value based in part on a conversion?

PRINCIPLES OF LAW

Obviousness

The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, and (3) the level of skill in the art. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966).

“What matters is the objective reach of the claim. If the claim extends to what is obvious, it is invalid under § 103.” *KSR Int’l Co. v. Teleflex, Inc.*, 550 U.S. 398, 419 (2007). To be nonobvious, an improvement must be “more than the predictable use of prior art elements according to their established functions.” *Id.* at 417.

Invention or discovery is the requirement which constitutes the foundation of the right to obtain a patent . . . unless more ingenuity and skill were required in making or applying the said improvement than are possessed by an ordinary mechanic acquainted with the business, there is an absence of that degree of skill and ingenuity which constitute the essential elements of every invention.

Dunbar v. Myers, 94 U.S. 187, 197 (1876) (citing *Hotchkiss v. Greenwood*, 52 U.S. 248, 267 (1850)) (*Hotchkiss v. Greenwood* was cited with approval by the Supreme Court in *KSR*, 550 U.S. at 406, 415, 427).

Appellants have the burden on appeal to the Board to demonstrate error in the Examiner's position. *See In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006). Therefore, we look to Appellants' Briefs to show error in the proffered prima facie case.

FINDINGS OF FACT

In our analysis *infra*, we rely on the following findings of fact (FF):

Dutta

1. Dutta is directed to data sharing in a computer (peer-to-peer) network. (Abst. ll. 1-3).

Schneider

2. Schneider is directed to a computer networking system (client-server) for three-dimensional graphics-transmission. (Abst. ll. 1-3 and col. 2, ll. 33-36)

3. Schneider discloses determining if a model is stored in the requested format. If the model is not stored in the proper format, the model is converted and sent to the client. (See col. 5, ll. 25-34 and col. 4, ll. 57-59).

Meempat

4. Meempat is directed to a computer (packet-based) network. (Abst. 11. 1-2)

5. Meempat discloses a cost metric that is determined for each link at a data measuring point. (Abst. ll. 7-11 and col. 2, ll. 20-25)

Carolan

6. Carolan is directed to a file conversion system for network computing. (Abst. ll. 1-3).

7. Carolan discloses determining the cost of performing conversions using different conversion engines. Once the least cost conversion is determined, the file is converted and sent to the computing platform or platforms on which the required conversion engine or engines are executing. (Col. 6, ll. 1-13).

ANALYSIS

We address Appellants' arguments in the order presented. Appellants present arguments directed to the combinability of the four base references (Dutta, Schneider, Meempat, Carolan) that are common to each rejection before us on appeal. (App. Br. 12-19). We address this threshold combinability issue separately below. (Issue 1). Regarding the limitations argued by Appellants with respect to independent claim 80 (App. Br. 14-17), we note that Appellants repeat the arguments submitted for claim 80 for the rejections of claims 92-94, 96, 100-102 and 105-107. (App. Br. 18-20). See Issues 2 and 3 *infra* regarding these argued limitations.

We only address the substantive arguments made by Appellants. A statement which merely points out what a claim recites will not be considered an argument for separate patentability of the claim. *See* 37

C.F.R. § 41.37(c)(1)(vii). See *e.g.*, the middle paragraph of page 15 of the principal Brief. See also *Ex parte Belinne*, No. 2009-004693, slip op. at 7-8 (BPAI Aug. 10, 2009) (informative), available at <http://www.uspto.gov/web/offices/dcom/bpai/its/fd09004693.pdf>

Issue 1

Combinability under 35 U.S.C. § 103

We decide the question of whether Appellants have shown the Examiner erred in finding that the Dutta, Schneider, Meempat, and Carolan references are combinable under 35 U.S.C. § 103.

At the outset, to the extent that Appellants contend that combining four references is an indication of non-obviousness, (App. Br. 17) we note that “[t]he criterion, however, is not the number of references, but what they would have meant to a person of ordinary skill in the field of the invention.” Reliance on a large number of references in a rejection does not, without more, weigh against the obviousness of the claimed invention. *In re Gorman*, 933 F.2d 982, 986 (Fed. Cir. 1991).

Here, we find that each of the references relied on by the Examiner is directed to the same *general* field of endeavor as the instant invention on appeal, i.e., computer networks. (See FF 1-7). Thus, we agree with the Examiner’s finding that each of the cited references is analogous art to the claimed invention.³ (Ans. 21).

³ “Whether a reference in the prior art is analogous is a fact question.” *In re Clay*, 966 F.2d 656, 658 (Fed. Cir. 1992) (citing *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1568 n.9 (Fed. Cir. 1987)). Two criteria

Moreover, the Supreme Court has determined that the conclusion of obviousness *can* be based on the interrelated teachings of multiple patents, the effects of demands known to the design community or present in the marketplace, and the background knowledge possessed by a person having ordinary skill in the art, and an obviousness “analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *KSR*, 550 U.S. at 418. See also *Dystar Textilfarben GmbH & Co. Deutschland KG v. C.H. Patrick Co.*, 464 F.3d 1356, 1368 (Fed. Cir. 2006).

Here, it is our view that an artisan possessing common sense and creativity at the time of the invention would have been familiar with various methods of file conversion and file transfer in different types of computer network systems, including both client/server and peer-to-peer networks. (See FF 1-7). While we are fully aware that hindsight bias often plagues determinations of obviousness, *Graham v. John Deere Co.*, 383 U.S. 1, 36 (1966), we are also mindful that the Supreme Court has clearly stated that the “combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results,” *KSR* 550 U.S. at 401.

have evolved for answering the question: “(1) whether the art is from the same field of endeavor, regardless of the problem addressed, and (2) if the reference is not within the field of the inventor's endeavor, whether the reference still is reasonably pertinent to the particular problem with which the inventor is involved.” *Id.* at 658-59 (citing *In re Deminski*, 796 F.2d 436, 442 (Fed. Cir. 1986); *In re Wood*, 599 F.2d 1032, 1036 (CCPA 1979)).

This reasoning is applicable here. Thus, we find unavailing (and untimely) Appellants contention in the Reply Brief that the Examiner has relied on impermissible hindsight reconstruction (Reply Br. 9).⁴ Given the breadth of Appellants' claims, we are not persuaded that combining the respective familiar elements of the cited references in the manner proffered by the Examiner was "uniquely challenging or difficult for one of ordinary skill in the art" (see *Leapfrog Enters., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1162 (Fed. Cir. 2007) (citing *KSR*, 550 U.S. at 418)). Therefore, we find the Examiner's proffered combination of familiar prior art elements according to their established functions would have conveyed a reasonable expectation of success to a person of ordinary skill having common sense at the time of the invention.

Lastly, we note that Appellants have not rebutted the Examiner's legal conclusion of obviousness by showing that the claimed combination of familiar elements produces any new function. Appellants have not provided any factual evidence of secondary considerations, such as unexpected or unpredictable results, commercial success, or long felt but unmet need.

⁴ Cf. "[I]t is inappropriate for appellants to discuss in their reply brief matters not raised in ... the principal brief[]. Reply briefs are to be used to reply to matter[s] raised in the brief of the appellee." *Kaufman Company v. Lantech, Inc.*, 807 F.2d 970, 973 n.* (Fed. Cir. 1986).

Therefore, we find Appellants' arguments unavailing regarding the combinability of the Dutta, Schneider, Meempat and Carolan references for essentially the same reasons proffered by the Examiner in the Answer (17-21), and as further discussed above. Accordingly, we find Appellants have not shown the Examiner erred by improperly combining the cited references under § 103.

Issue 2

We decide the question of whether Appellants have shown the Examiner erred in finding that the cited references teach or would have suggested the limitation of specifying a format for the data.

Appellants argue that the teachings of Schneider would not have "logically commended themselves to an inventor's attention when he/she was considering the problems addressed in the peer-to-peer data network of Dutta." (App. Br. 16). We note that Schneider discloses determining if a model is stored in the requested format. If the model is not stored in the proper format, the model is converted and sent to the client. (FF 3). Therefore, we find Schneider teaches or would have suggested specifying a format for the data in the manner claimed. Although Schneider is directed to a graphics transmission system in a client/server network (FF 2), as discussed above, it is our view that an artisan possessing common sense and creativity at the time of the invention would have been familiar with various methods of file conversion and file transfer in different types of computer

network systems, including both client/server and peer-to-peer networks. (See FF 1-7). Therefore, we find that Appellants have not shown error in the Examiner's prima facie case of obviousness regarding the argued limitation of specifying a format for the data.

Issue 3

We decide the question of whether Appellants have shown the Examiner erred in finding that the cited references teach or would have suggested generating a cost value based in part on a conversion. We note that the Examiner relied on Carolan to disclose generating a cost value based in part on a conversion. (Ans. 5-6). Thus, it is our view that Meempat is a cumulative reference that further evidences it was well known in the art to generate cost values in a computer network.

We agree with the Examiner that Carolan discloses generating a cost value based on a conversion. (FF 6-7). Regarding Carolan, Appellants also contend that the Examiner has not established that the teachings of Carolan are combinable with Dutta. (App. Br. 17). We have fully addressed Appellants' combinability argument *supra*.

Based on the record before us, we find Appellants have not shown error in the Examiner's prima facie case of obviousness regarding the argued limitation of generating a cost value based in part on a conversion.

CONCLUSIONS

1. Appellants have not shown the Examiner erred in combining the cited references.
2. Appellants have not shown the Examiner erred in finding that the cited references teach or would have suggested specifying a format for the data.
3. Appellants have not shown the Examiner erred in finding that the cited references teach or would have suggested generating a cost value based in part on a conversion.

DECISION

The Examiner's decision rejecting claims 80-109 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. §1.136(a). See 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

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